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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/971,903	11/17/1997	HIROSHI HARUKI	826.1431/JDH	4920

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EXAMINER

MYHRE, JAMES W

ART UNIT PAPER NUMBER

2162

DATE MAILED: 11/19/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

	Application No. 08/971,903	Applicant(s) Haruki et al
	Examiner James W. Myhre	Art Unit 2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Sep 27, 2001

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-8 and 10-20 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-8 and 10-20 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

15)  Notice of References Cited (PTO-892) 18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 19)  Notice of Informal Patent Application (PTO-152)

17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20)  Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Request for Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 27, 2001 has been entered.

### ***Response to Amendment***

2. The amendment filed on September 27, 2001 has been considered but is ineffective to overcome the Hill (5,761,649), Peschel ("Unfurled"), and Bisson ("Mpresswire") references. However, after further search, the Examiner has found additional prior art which has been used in the following rejection of all claims in lieu of the above cited references.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1-8 and 10-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Todd et al (5,867,714).

Claims 1, 10-13, 16, and 17: Todd discloses a system and method for registering and updating software on a remote computer, comprising:

a. User information general management means managing user registration information and status information by managing product information data and providing new or updated information in accordance with a request from a user (col 13, lines 45-49 and col 14, lines 25-35); and

b. User registration/reference means for notifying the general management means of the user registration and status information and for requesting new information about the product (col 12, lines 30-65);

c. Extracting information about the new or updated product from one of the remote databases and transmitting the information to the user (col 14, lines 25-35);

Todd further discloses tracking usage data (i.e. number of uses) and using the data to provide targeted suggestions/offers to the user (col 4, lines 31-34 and col 12, lines 30-65)

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Claim 2: Todd discloses a system and method for registering and updating software on a remote computer as in Claim 1 above, and further discloses means for the user to request new information about a product from the general management means (col 13, lines 45-49; col 14, lines 1-5; and col 14, lines 26-36).

Claim 3: Todd discloses a system and method for registering and updating software on a remote computer as in Claim 2 above, and further discloses the registration process being built into the software and automatically executed upon installation on the user's computer (col 6, lines 50-55 and col 11, lines 43-58).

Claim 4: Todd discloses a system and method for registering and updating software on a remote computer as in Claim 2 above, and further discloses:

- a. A personal identification number as part of the registration information (col 13, lines 45-49 and col 14, lines 25-35); and
- b. The type of requested information which is extracted by the general management means and transmitted to the user (col 13, lines 47-49; col 14, lines 1-5; and col 14, lines 26-36).

Claims 5 and 6: Todd discloses a system and method for registering and updating software on a remote computer as in Claim 2 above, and further discloses basing the automatic update of the software on the number of times the application had been accessed. Todd discloses a subscription-based service that analyzes license and maintenance agreements before updating the software (col 12, lines 58-65) and that usage data is being tracked (col 4, lines 31-34 and col 12,

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lines 30-65). This infers that the subscription is based on the usage of software (i.e. number of uses), probably also tied to a predetermined time period (i.e. 10 uses per month)

Claims 7, 8, 14, 15, and 18-20: Todd discloses a system and method for registering and updating software on a remote computer as in Claim 2 above, and further discloses multiple vendors (remote data sources)(col 13, lines 16-28) updating the product information database of the general management means by providing new information pertaining to the type of product as requested by the user (col 12, lines 21-29 and col 12, lines 49-65). Todd discloses that the data is being revised on the remote data source which is part of a network of processing systems (col 13, lines 16-19) and contains a library of revisions (col 14, lines 18-20). Todd's further disclosure that the user may be able to actually purchase the update/new software from the remote data source (col 12, lines 53-57) and that at least one of the remote data servers could be a central data source (col 14, lines 41-46), infers that the central data source is being updated by the other remote data sources (i.e. vendor/manufacturer).

#### *Response to Arguments*

5. Applicant's arguments with respect to claims 1-8 and 10-20 have been considered but are moot in view of the new ground(s) of rejection.

a. Fawcett (5,845,077 and 6,073,214) discloses a method and system for automatically identifying and obtaining updates for software on a user's computer from a remote data source. The system also automatically notifies the user about new products and enhanced versions of

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existing products which can be obtained electronically from the remote data source. Either reference could be used in a 35 U.S.C. 102 rejection of all pending claims in place of the Todd reference above.

b. Slivka et al (6,049,671) discloses a method and system for automatically determining and obtaining updates for software on a user's computer from a remote data source. The system also automatically notifies the user about new products and enhanced versions of existing products which can be obtained electronically from the remote data source. This reference could be used in a 35 U.S.C. 102 rejection of all pending claims in place of the Todd reference above.

c. Edwards, Jr. (5,014,234) discloses a method and system for limiting the usage of a software product by tracking the number of uses by a customer or the amount of time since the purchase of the software. This reference could be used in support of a 35 U.S.C. 103 rejection of all pending claims based on tracking the number of uses.

d. Michel et al (5,625,690) discloses a method and system for managing pay-per-use software by tracking the number of uses by a customer. This reference could be used in support of a 35 U.S.C. 103 rejection of all pending claims based on tracking the number of uses.

e. Toader (5,806,043) discloses a method and system for managing Internet access by a customer by tracking the number of accesses (uses) by the customer. This reference could be used in support of a 35 U.S.C. 103 rejection of all pending claims based on tracking the number of uses.

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f. Zale et al (6,233,536) discloses a method and system for monitoring the lifecycles of computer products based on the number of uses or amount of time that has passed since the product was purchased. This reference could be used in support of a 35 U.S.C. 103 rejection of all pending claims based on tracking the number of uses.

g. Revashetti et al (6,230,199) discloses a method and system for presenting marketing opportunities to a customer based on the information maintained about the products (software) on the customer's computer. This reference is cited to show the current state of the art in tracking a user's software and in using such information to target suggestions/advertisements to the user.

h. Smith et al (WO 95/34857) discloses a method and system for monitoring and tracking the registration and licensing of software on a customer's computer. The system tracks the amount of usage, compares it to the amount of usage prepaid for by the customer, and notifies the customer when it is time to update the software and/or license. This reference could be used in support of a 35 U.S.C. 103 rejection of all pending claims based on registering the customer and software.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal of Official faxes to Technology Center 2100 is (703) 746-7239 or 7238. Draft or Informal faxes

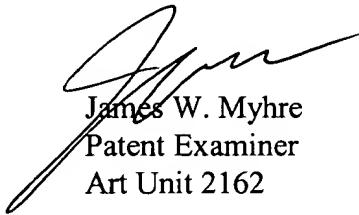
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for this Art Unit can be submitted to (703) 746-7240. Draft faxes may also be submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-3900.

JWM

November 9, 2001



James W. Myhre  
Patent Examiner  
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